

REMARKS

Favorable reconsideration and allowance of the claims presented herein are respectfully requested.

Claims 1-24 are pending in this application and Claims 25-52 have been withdrawn from consideration by the Examiner as being drawn to a non-elected invention. By this Amendment, Claims 1, 3, 5, 13, 15 and 17 have been amended. Applicants respectfully request that no new matter has been added to the subject invention.

In the Office Action, the Examiner issued a requirement for restriction under 35 U.S.C. '121 categorizing original Claims 1-52 as follows: Group I made up of Claims 1-24 drawn to a liquid microemulsion and process of making thereof, classified in class 252, subclass 182.28; and Group II made up of Claims 25-39 and 43-52, drawn to a halogen containing polymer and process of making thereof, classified in class 524, subclass 395; and Group III made up of Claims 40-42, drawn to a food grade article of manufacture, classified in class 428, subclass 1+. A provisional election was made by applicants with traverse to prosecute the invention of Group I. Applicants elect herein, with traverse, the subject matter of the claims of Group I, i.e., Claims 1-24, for examination in this application.

Applicants respectfully reserve the right to file one or more divisional applications to non-elected Claims 25-52 in the event the Examiner's restriction requirement is made final and such claims are canceled from the present application.

It is respectfully submitted that the requirement for restriction between the claims of Group I, Group II and Group III is improper and should be withdrawn.

Restriction is proper only if the claims are either independent or patentably distinct and the search and examination of the entire application would impose a serious burden on the Examiner (MPEP ' 803). Applicants respectfully traverse the restriction requirement because the

Examiner has not provided sufficient reasons to show that such a burden exists. Here, all of applicants' claims are directed either to overbased metal carbonate/carboxylate liquid microemulsions or the process of preparing these same microemulsions. Applicants submit that the Examiner, in searching for overbased metal carbonate/carboxylate liquid microemulsions as claimed by applicants, would necessarily find art related to liquid microemulsions (the claims of Group I) and halogen-containing polymers comprising a halogen containing polymer and a heat stabilizing effective amount of a microemulsion and process of making thereof (the claims of Group II) and a food grade article of manufacture containing the halogen-containing polymers (the claims of Group III).

Accordingly, applicants respectfully request that the Examiner withdraw, or at the very least modify, the requirement for restriction and provide an action on the merits of nonelected Claims 25-52.

Applicants acknowledge the requirement set forth in the Office Action for a new oath or declaration properly identifying the application of which it is to form a part. Accordingly, a new oath or declaration properly identifying the application is enclosed herein.

The Examiner has rejected Claims 5 and 17 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The Examiner alleges that Claims 5 and 17 lack antecedent basis in the claims from which these claims depend for the phrase, "basic metal compound". Although not necessarily agreeing with the Examiner, applicants have amended Claims 5 and 17 in a manner believed to obviate this rejection. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has objected to Claims 3, 4, 15 and 16 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. In

response to the Examiner's objection, applicants have amended Claim 3 and 15 in a manner believed to obviate this rejection. Accordingly, withdrawal of the objection is respectfully requested.

The Examiner has rejected Claims 1-3, 5-7, 13-15, 17-19 and 22-22 under 35 U.S.C. §102 (e) as being anticipated by U.S. Patent No. 6,689,893 ("Reddy").

Nowhere does Reddy disclose or suggest a liquid microemulsion comprising, *inter alia*, component (c) being "one or more polyols, or ethoxylates and/or propoxylates of an alcohol having from about 6 to about 24 carbon atoms" as presently recited in amended Claims 1 and 13. Rather, Reddy discloses a microemulsion containing, *inter alia*, butyl Carbitol and isodecanol. One skilled in the art of chemistry would readily understand that butyl Carbitol, (i.e., diethylene glycol monobutyl ether) is not an ethoxylate and/or propoxylate of an alcohol having from about 6 to about 24 carbon atoms. Accordingly, in lacking any disclosure or suggestion of a microemulsion containing, *inter alia*, "ethoxylates and/or propoxylates of an alcohol having from about 6 to about 24 carbon atoms", amended Claims 1 and 13 are believed to be patentable over Reddy.

The Examiner has rejected Claims 4, 8-12, 16, 20-21 and 24 under 35 U.S.C. §103(a) as being obvious over Reddy in view of either U.S. Patent No. 4,060,508 ("Sughara") or U.S. Patent No. 4,501,840 ("Werle") (for all said claims except 4 and 16).

As pointed out by the Examiner, Reddy differs from applicants' claimed invention, i.e., Claims 4 and 16, in that there is no direct disclosure to add an organic material that is selected from ethoxylated alcohols to the overbased microemulsions.

Sughara fails to cure the deficiencies of Reddy. Rather, Sughara discloses an inorganic stabilizer having a pore volume of at least 0.5cc/g and consisting essentially of (a) at least one member selected from the groups consisting of silicates of metals of Groups II and IV of the

Periodic Table and composites of silicic acid with oxides, hydroxides and carbonates of these metals and (b) an organic additive for impregnating and permeating into the pores of the stabilizer. Sughara further discloses that the stabilizer is of powder or granular form in which the granules may be coated. At no point however is it seen where Sughara provides any suggestion, motivation or even a hint of adding to an oil an organic material which is readily soluble or miscible with the oil for reacting an oxide and/or hydroxide of a metal selected from the group consisting of sodium, potassium, calcium, magnesium, zinc and mixtures thereof, with an aliphatic acid to prepare a liquid microemulsion. Instead, Sughara merely discloses solid silicate-based stabilizers. Thus, nothing in Sughara would lead one skilled in the art to look to Sughara to modify the microemulsion of Reddy and arrive at the presently claimed liquid microemulsion with any expectation of success.

Besides, it is well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. *In re Lee*, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433-34 (CAFC 2002). Certainly, as discussed above, Sughara does not provide any such teaching, suggestion or incentive to add organic material that is selected from ethoxylated alcohols or propoxylated alcohols to the liquid microemulsions as set forth in dependent Claims 4 and 16. Thus, one skilled in the art would not be motivated by the Sughara reference to modify the overbased microemulsions of Reddy to arrive at the presently claimed liquid microemulsion compositions of Claim 4 and 16 with any expectation of success.

For the foregoing reasons, Claims 4 and 16 are believed to be nonobvious, and therefore patentable, over Reddy in view of Sughara. Accordingly, withdrawal of the rejection of Claims 4 and 16 under 35 U.S.C. § 103(a) is respectfully requested.

With respect to Claims 8-12, 20 and 21, as pointed out by the Examiner, Reddy differs from the applicants' claimed invention in that there is no direct disclosure to applicants' claimed invention wherein glycerin and sorbitol are used either individually or together as co-stabilizers with the taught alkaline earth metal carbonate/carboxylate salt stabilizer containing microemulsions.

Sughara fails to cure the deficiencies of Reddy. Rather, as previously discussed, Sughara discloses an solid inorganic stabilizers having a pore volume of at least 0.5cc/g and consisting essentially of (a) at least one member selected from the groups consisting of silicates of metals of Groups II and IV of the Periodic Table and composites of silicic acid with oxides, hydroxides and carbonates of these metals and (b) an organic additive for impregnating and permeating into the pores of the stabilizer. At no point however is it seen where Sughara provides any suggestion, motivation or even a hint of adding a polyol selected from the group consisting of sorbitol, pentaerythritol, sugar alcohols and mixtures to a liquid microemulsion to catalyze the reaction and form a homogenous liquid microemulsion. Instead, Sughara merely discloses impregnating and permeating a polyhydric alcohol such as sorbitol or pentaerythritol into the pores of the solid silicate-based stabilizers. Thus, nothing in Sughara would lead one skilled in the art to look to the polyhydric alcohols for impregnating and permeating into the pores of the solid silicate-based stabilizers disclosed therein to modify the microemulsion of Reddy and arrive at the presently claimed liquid microemulsion.

Besides, as stated above, it is well established that there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. *In re Lee*, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433-34 (CAFC 2002). Certainly, as discussed above, Sughara does not provide any such teaching, suggestion or incentive to add a polyhydric alcohol such as sorbitol or pentaerythritol to the liquid

microemulsions as set forth in Claims 8-12, 20 and 21. Thus, one skilled in the art would not be motivated by Sughara to modify the overbased microemulsions of Reddy to arrive at the presently claimed liquid microemulsion compositions of Claims 8-12, 20 and 21 with any expectation of success.

The Examiner alleges that “[i]t would have been obvious to one having ordinary skill in the art to use the direct disclosure to glycerin and/or sorbitol as effective stabilizers for chlorine-containing polymers as strong motivation to actually use them as co-stabilizers in the overbased microemulsions taught by Reddy et al”. This wholly unsupported allegation cannot possibly serve as a basis for this rejection. If it is the Examiner’s position that one of ordinary skill in the art, upon inspection of Sughara, would be motivated by the direct disclosure to glycerin and/or sorbitol for impregnating and permeating the pores of a silicate-based solid stabilizer and use them for forming liquid microemulsions, then the Examiner is respectfully requested to explain with reasons of particularity why one skilled in the art would be motivated to combine the references. Accordingly, Claims 8-12, 20-21, and 24 are believed to be nonobvious, and therefore patentable, over Reddy in view of Sughara. Thus, withdrawal of the rejection of Claims 8-12, 20-21, and 24 under 35 U.S.C. § 103(a) is respectfully requested.

Furthermore, the Examiner alleges that Claims 8-12, 20-21 and 24 are obvious in view of Werle. However, Werle likewise fails to cure the deficiencies of Reddy. Specifically, nowhere does Werle provides any disclosure, suggestion, or even a hint of employing polyhydric alcohols such as sorbitol and glycerin as effective co-stabilizers with overbased metal carboxylate stabilizers in microemulsions.

Rather, Werle discloses a process for producing a costabilizer suitable for the stabilization of polyvinyl chloride in which the final costabilizer product is a solid at room temperature and reduces to a powder, preferably with a particle size below 0.1mm, see col. 3

lines 4-5. At no point is it seen where there is any suggestion, motivation or even a hint in Werle of the use of polyhydric alcohol such as sorbitol and glycerin in a microemulsion to catalyze the reaction and form a homogenous liquid microemulsion.. Thus, nothing in Werle would lead one skilled in the art to choose the polyhydric alcohol, such as sorbitol or glycerin, used in the solid composition of Werle for use in a liquid microemulsion.

Moreover, as Werle merely discloses the use of polyhydric alcohols, such as sorbitol and glycerin, in solid composition, Werle cannot possibly provide any suggestion or motivation to use polyhydric alcohols in a liquid microemulsion. As the court pointed out in *In re Lee*, 277 F.3d 1338, 1342-43, 61 USPQ2d 1430, 1433-34 (CAFC 2002), there must be some teaching, motivation or suggestion to select and combine references relied upon as evidence of obviousness. Certainly, as discussed above, Werle does not provide any such teaching, suggestion or incentive to use polyhydric alcohols in a liquid microemulsions. Thus, one skilled in the art would not be motivated by the Werle reference to modify the microemulsions of Reddy to arrive at the presently claimed liquid microemulsions of Claim 8-12, 20-21 and 24 with any expectation of success. Accordingly, withdrawal of the rejection of Claims 8-12, 20-21 and 24 under 35U.S.C§103(a) is respectfully requested.

The Examiner has next rejected Claims 4 and 16 under 35 U.S.C. §103(a) as obvious over Reddy in view of Benda et al. U.S. Patent No. 5,501,807 (“Benda”) or Dworkin et al. U.S. Patent No. 4,085,077 (“Dworkin”).

The Examiner states that Reddy differs from applicants’ invention in that there is no direct disclosure to add an organic material that is a substituted or unsubstituted aromatic hydrocarbon and that Benda teaches overbased metal carboxylates compositions that use aromatic compounds, such as toluene, benzene and naptha as solvents.

However, Benda does not cure the above-noted deficiencies of Reddy. Specifically, Benda nowhere discloses or suggests adding to an oil an organic material which is readily soluble or miscible with the oil for reacting an oxide and/or hydroxide of a metal selected from the group consisting of sodium, potassium, calcium, magnesium, zinc and mixtures thereof, with an aliphatic acid to prepare a liquid microemulsion as generally recited in Claims 4 and 16. Rather, Benda merely discloses a process for the production of basic calcium carboxylic acid salts. Thus, one skilled in the art would not be motivated by Benda to modify the overbased microemulsion composition of Reddy to arrive at the presently claimed liquid microemulsions of Claims 4 and 16 with any expectation of success.

For the foregoing reasons, Claims 4 and 16 are believed to be nonobvious, and therefore patentable, over Reddy in view of Benda. Accordingly, withdrawal of the rejection of Claims 4 and 16 under 35 U.S.C. § 103(a) is therefore respectfully requested.

With respect to the rejection based on Reddy in view of Dworkin, the Examiner states that Reddy differs from applicants' invention in that there is no direct disclosure to add an organic material that is a substituted or unsubstituted aromatic hydrocarbon and that Dworkin teaches a method for stabilizing vinyl chlorine polymers using overbased compositions that comprise metal carboxylates in combination with other ingredients, one of which is a solvent, such as naptha, benzene, toluene, mineral oil etc.

However, Dworkin does not cure the above-noted deficiencies of Reddy. Specifically, Dworkin nowhere discloses or suggests adding to an oil an organic material which is readily soluble or miscible with the oil for reacting an oxide and/or hydroxide of a metal selected from the group consisting of sodium, potassium, calcium, magnesium, zinc and mixtures thereof, with an aliphatic acid to prepare a liquid microemulsion as generally recited in Claim 4 and Claim 16. Rather, Dworkin merely discloses the reaction between mono- or dicarboxylic acid and a

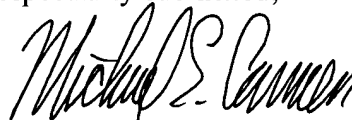
stoichiometric excess of a diarganotin oxide in the presence of an organic media. Dworkin further discloses that the product of the reaction disclosed in Dworkin is a solid material (see, col. 2 line 41 and Example 1). Thus, one skilled in the art would not be motivated by Dworkin to modify the overbased microemulsion composition of Reddy to arrive at the presently claimed liquid microemulsions of Claims 4 and 16 with any expectation of success.

For the foregoing reasons, Claims 4 and 16 are believed to be nonobvious, and therefore patentable, over Reddy in view of Dworkin. Accordingly, withdrawal of the rejection of Claims 4 and 16 under 35 U.S.C. § 103(a) is therefore respectfully requested.

The Examiner has provisionally rejected Claims 1-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-24 of co-pending Application No. 10/191,440. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

For the foregoing reasons, amended Claims 1-24 as presented herein are believed to be in condition for immediate allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen". The signature is fluid and cursive, with the first and last names being more prominent.

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